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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,262	01/15/2002	Ronald A. Holland	C43770/126119	4517

7590 01/11/2005

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,262

Applicant(s)

HOLLAND, RONALD A.

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-11, 15-18, 22-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-11, 15-18, 22-25, 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed October 1, 2004 has been entered. Claims 5-7, 12-14, 19-21, and 26-28 are canceled. Claims 1-4, 8-11, 15-18, 22-25, and 29 are pending and have been considered on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 8 defines an incline of approximately twenty-five degrees rearward from vertical. Lines 4 and 5 of paragraph 22 of the specification indicate that variations in the inclination are possible. However, the specification does not disclose a specific inclination of approximately twenty-five degrees.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8-11, 15-18, 22-25, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 15, and 29 require the braking device to have a coefficient of friction with the braking wheel that is less than the coefficient of friction between the braking wheel and skating surface. However, the claims do not define the characteristics of the skating surface and, thus, fail to establish a coefficient of friction between the braking wheel and skating surface. Since the claims define the coefficient of friction for the braking device as a function of the coefficient of friction between the braking wheel and skating surface, the coefficient of friction for the braking device cannot be definitely determined. Also, since the skate may be used on a variety of skating surfaces, the claimed coefficient of friction for the braking device will vary as skating surfaces vary. Such a variance in the coefficient of friction would require a variance in the physical characteristics of the braking device while a user is operating the skate, and the disclosure does not explained how the physical characteristics of the braking device may vary while a user is operating the skate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 5,924,704 in view of Holland US 6,425,588.

Johnson discloses an in-line roller skate having a boot 5, a frame secured to the boot and formed by the base of the boot shell and bracket 4, a plurality of skating wheels 1 and 3 rotatably mounted on the frame, a counter-rotatable braking device 6 rotatably attached to the frame, and a braking wheel 2 rotatably attached to the frame. The braking device includes means 38, 39 to allow rotation of the device in one direction and to resist rotation in the other direction. The braking wheel is attached to the frame by a mechanism for slidably attaching an axle to the frame that allows displacement of the axle in the upward direction of the braking device so that the braking wheel may contact the braking device. This mechanism comprises a pair of parallel elongated slots in the frame, which accommodate insert 23, with the wheel axle slidably mounted in the slots on which the braking wheel 2 is mounted. In addition, the braking device is approximately in line with the axes of the slots and is mounted on an axle 10 that is fixedly attached to the frame.

The contact point between the braking wheel and the braking device is approximately vertically above the contact point between the braking wheel and the skating surface when the skating wheel adjacent to the braking wheel and the braking wheel are both in contact with the skating surface. The braking device is oriented to allow rotation of the braking wheel against the skating surface in the forward skating direction and to resist rotation of the braking wheel against the skating surface in the reverse direction. Also, the counter-rotatable braking device, the braking wheel and

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the skating wheels are in a common plane of rotation. See Figures 2 and 6A-6C; column 3, lines 34-39; and column 4, lines 1-39.

Johnson discloses the braking device and braking wheel at the rear end of the frame, rather than the claimed forward end. Also, Johnson does not disclose the nature of the coefficient of friction of the braking device. However, Holland teaches the desirability of arranging a braking device and braking wheel at the forward end of a skate. See Figures 1-3. Holland further teaches the desirability of utilizing a brake device having a coefficient of friction with the braking wheel that is less than the coefficient of friction between the braking wheel and skating surface. See column 4, lines 37-43. From the teachings of Holland, arranging the braking device, braking wheel, and slots of Johnson at the forward end of the frame, rather than the rear end, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would assist the operator in starting and accelerating. Moreover, this would dispose the skating wheels rearward of the slot. From the further teachings of Holland, providing the braking device of Johnson with a coefficient of friction with the braking wheel that is less than the coefficient of friction between the braking wheel and skating surface would have been obvious to one of ordinary skill in the art at the time the invention was made. This would minimize the likelihood of skidding when applying the brake.

Claims 3, 4, 15-18, 22-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 5,924,704 in view of Holland US 6,425,588 as applied to claims 1, 2, and 9-11 above, and further in view of Riutta US 5,192,099.

Johnson does not disclose that the long axes of the slots are inclined rearward approximately ten degrees from vertical. However, Riutta teaches the old and well known practice of arranging slots 56 on a skate frame at a rearward incline. See Figure 4 and also see slot 38 in Figure 5. From the teaching of Riutta, arranging the slots of Johnson at a rearward incline would have been obvious to one of ordinary skill in the art at the time the invention was made. This would improve the efficiency of the brake device of Johnson by maintaining more direct alignment between the sliding motion of the braking wheel and the braking device when the skate is oriented at an angle during a forward skating motion. This modification would necessarily result in the braking device of Johnson being approximately in line with the axes of the slots and would allow the axis of the braking wheel to displace in a direction approximately in line with the axis of the braking device, such that the braking wheel may displace in an upward direction inclined rearward from vertical and contacts the braking device.

Moreover, the depiction of slots 56 and 38 in Figures 4 and 5 of Riutta suggest that the slots are oriented approximately ten degrees from vertical. From this teaching of Riutta, orienting the slots of Johnson approximately ten degrees from vertical would have been obvious so that the incline of the slots would be oriented for optimum efficiency when the skate is at an angle during a forward skating motion. Also, the claimed range of approximately ten degrees does not distinguish over the prior art

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because the claimed range and the range of Riutta overlap, or at least are close enough that one of ordinary skill in the art would have expected them to have the same properties. See *Titanium Metals Corp. of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

Response to Arguments

Applicant's arguments filed October 1, 2004 have been fully considered but they are not persuasive. As discussed above, the claims are not in condition for allowance.

In regard to Applicant's assertion that the specification supports the limitation of 25 degrees in claim 8, the statement in the specification that "substantial variations in the inclination of slot 34 are possible" does not support the claimed limitation of 25 degrees. The expression "substantial variations" is vague and the disclosure does not establish the range of variations that qualify as "substantial." In particular, the specification does not provide a basis for the suggestion that a variation of 15 degrees qualifies as a substantial variation within the scope of the disclosure.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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